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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 10/626,814 | 07/23/2003 | Jeffrey Alan Miks | AMKOR-042B1 | 2541 |
| 7590 | 07/22/2005 | | EXAMINER PERT, EVAN T | |
| Mark B. Garred STETINA BRUNDA GARRED & BRUCKER Suite 250 75 Enterprise Aliso Viejo, CA 92656 | | | ART UNIT 2826 | PAPER NUMBER |

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,814

Applicant(s)

MIKS ET AL.

Examiner

Evan Pert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-21 is/are pending in the application.
4a) Of the above claim(s) 5-8, 13-16, 20 and 21 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 9-12, 17 and 19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12-15-03, 12-22-03, 6-23-04
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 5-8, 13-16 and 20-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 18, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 4, 9-10, 12 and 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lee et al. (US 6,603,196 B2). See contact 321 of cover figure such that socket for MMC does not scrape over mold resin of "body," with "seven" contacts per Fig. 1A lead frame, encapsulation "body" 350, etc..

4. Claims 1-2, 9-10 and 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Houdeau et al. (US 6,209,790 B1). See contacts 2 of cover figure in view of claim 2, with col. 3, lines 40-43, etc..

5. As is a particular feature of applicant's claimed invention, likewise, the contacts of the memory cards of the Lee et al. and Houdeau et al. references extend to the sides of the card and the socket connector does not travel over the resin body in either invention.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Lee et al. or Houdeau et al., as applied to claims 1, 9 and 17 above, and further in view of Bolkon (US 6,444,501).

The Lee et al. and Houdeau et al. references are silent about the claimed "sloped side" that is equivalent to a chopped off corner, or "chamfered corner 98" as described by Bolkon (US 6,444,501):

The purpose of the chamfered corner 98 is to generally identify the end of the semiconductor card 10 having external contacts 24 and to ensure that a user inserts the card in a proper orientation [col. 6, lines 44-51].

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to adopt the "chamfered corner" (i.e. "sloped side") of Bolkon, motivated, for example, to "ensure that a user inserts the card in a proper orientation [col. 6, lines 44-51].

8. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houdeau et al., as applied to claims 1 and 9 above, and further in view of Bolkon (US 6,444,501).

Houdeau et al. does not show "seven contacts," which are admitted as prior art by applicant.

The Houdeau et al. reference does explain that:

...there must be a number and positioning of contacts which is standard for the type of data medium, with the result that there is a required standardization for daily use with corresponding data-reading systems [col. 4, lines 5-9].

Bolkon shows "seven contacts" for a conventional MMC packaged in their invention (see Fig. 3).

It would have been obvious to adopt "seven contacts" in practicing the memory card invention of Houdeau et al., motivated for "standardization" to "seven contacts."

Information Disclosure Statements

9. The information disclosure statement filed December 22, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

10. The information disclosure statement filed December 22, 2003 also fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

11. 37 CFR 1.56 declares that Applicant has a duty to disclose all information known to be material to patentability; it is assumed that Applicant's IDS submissions of December 15, 2003, December 22, 2003 and June 23, 2004 were prepared to fulfill that duty.

However, a review of the references reveals that the IDS submissions contain numerous references that are not material to patentability and are superfluous to the determination of patentability. Since review of voluminous non-pertinent material places a burden on the Office, applicant's IDS places an unnecessary burden that detracts from examination of the claims.

3. MPEP 609 states:

Although a concise explanation of the relevance of the information is not required for English language information, Applicants are encouraged to provide a concise explanation of why the English language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and Applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and Applicant is aware that one or more are highly relevant to patentability.'

See also MPEP section 2004, paragraph 13:

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It is desirable to avoid the submission of long lists of documents if it can be avoided. Eliminate clearly irrelevant and marginally pertinent cumulative information. If a long list is submitted, highlight those documents which have been specifically brought to applicant's attention and/or are known to be of most significance. See *Penn Yan Boats, Inc v. Sea lark Boats, Inc*, 359 F. Supp. 948, 175 USPQ (S.D. Fla. 1972), *acæd*, 479 F 20 1338, 178 uspo 577 (5* cir. 1973), *cert. denied*, 414 u.s. 874 (1974). But *ct Molins PLC v. Textron J:c*, 48 F.3D 1172, 33 USPQ 2d 1823 (Fed. Cir. 1995).

See also *Ex #Jr/e Morning Surf corporation (BDPatApp&1nt)* 230 USPQ 446, 1986:

"on the other hand, to inundate the Examiner with a large volume of prior art that is not material may obscure a single reference that is material and thus may be effectively as improper as withholding a material reference. *Penn Yan Boats, Inc r. Sea lark Boats, Inc*. 359 F. Supp. 948, 175 USPQ (S.D. Fla. 1972."

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evan Pert whose telephone number is 571-272-1969.

The examiner can normally be reached on M-F (7:30AM-3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ETP
July 20, 2005



EVAN PERT
PRIMARY EXAMINER